

28 MAR 2006



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In re Application of	:	
Wu et al	:	DECISION ON
Application No.: 10/529,351	:	
PCT Application No.: PCT/US2003/28547	:	
Int. Filing Date: 29 September 2003	:	PETITION UNDER
Priority Date: 02 October 2002	:	
Attorney's Docket No.: P5101R1	:	
For: Compositions and Methods for the Diagnosis	:	37 CFR 1.48(b)
And Treatment of Tumor	:	

This response is to the "PETITION UNDER 37 CFR 1.48(b)" submitted on 06 February 2006.

BACKGROUND

On 29 September 2003, applicants filed international application No. PCT/US03/28547 designating the United States and claiming a priority date of 02 October 2002. Accordingly, the deadline for entry into the national stage by paying the basic national fee in the U.S. expired as of midnight of 04 April 2005.

On 25 March 2005, petitioner filed in the United States Patent & Trademark Office a transmittal letter for entry into the national stage in the U.S. under 35 U.S.C. 371, which was accompanied by, inter alia, the U.S. basic national fee. No executed oath or declaration accompanied the above papers.

On 08 September 2005, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) which informed applicant, inter alia, that an "Oath or Declaration of the inventors, in compliance with 37 CFR 1.497(a), and (b), identifying the application by International application number and international filing date." The notice indicated that all of the items set forth must be submitted within two (2) months from the date of this Notice or by 32 months from the priority date for the application, whichever is later. Failure to properly respond will result in abandonment.

On 06 February 2006, applicant filed, inter alia, and executed declaration, and a petition under 37 CFR 1.48(b) because due to the cancellation of certain claims, the contributions of inventor Yan Zhou is no longer being claimed as co-inventor in the aforementioned application.

DISCUSSION

A submission under 37 CFR 1.48(b) (nonprovisional application- fewer inventors due to amendment or cancellation of claims) must include:

- (1) a request signed by a party set forth in §1.33(b) to correct the inventorship that identifies the named inventor or inventors being deleted and acknowledges that the inventor's invention is no longer being claimed in the nonprovisional application; and
- (2) the processing fee set forth in § 1.17(i).

A review of the application file suggests that at the time of filing the international application Yan Zhou was correctly listed as a joint inventor of the invention. The submission under 37 CFR 1.48(b) is due to the deletion of certain claims attributed to the inventor. Specifically, the preliminary amendment submitted on 06 February 2006 cancelled claims 1-14 at entering the national stage. Under this situation, applicants are still required to file an oath or declaration with the signatures of all the inventors that are listed in the international application in order to enter the national stage. In this instance, Yan Zhou has not been listed in the declaration so the declaration has not been properly executed. Thus the requirements under 35 USC 371 have not been satisfied.

Accordingly, after the requirements under 35 USC 371 are satisfied, applicants may petition to the patent examiner under 37 CFR 1.48(b) to correct inventorship as a consequence of claim amendments.

CONCLUSION

For the reasons above, the request under 37 CFR 1.48(b) is held in ABEYANCE until the requirements under 35 USC 371 are met.

If reconsideration on the merits of this petition is desired, a proper reply is an executed oath or declaration with the signatures of all the inventors that are listed in the international application must be filed within TWO (2) MONTHS from the mail date of this decision. The failure to provide the proper reply will result in Abandonment of the application. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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